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NOTIFICATION OF THE RECORDING
OF A CHANGE

(PCT Rule 92bis.1 and
Administrative Instructions, Section 422)

From the INTERNATIONAL BUREAU

To:

CIBA SPECIALTY CHEMICALS HOLDING
INC.
Patentabteilung
Klybeckstrasse 141
CH-4057 Basel
SUISSE

Date of mailing (day/month/year)
19 March 2001 (19.03.01)

Applicant's or agent's file reference
A-21851/A

International application No.
PCT/EP99/07616

IMPORTANT NOTIFICATION

International filing date (day/month/year)
11 October 1999 (11.10.99)

1. The following indications appeared on record concerning:

☒ the applicant ☒ the inventor ☐ the agent ☐ the common representative

Name and Address

JEGANATHAN, Suruliappa, Gowper
4002 Fox Pointe Court
Glenmills, PA 19342
United States of America

State of Nationality

IN

State of Residence

US

Telephone No.

Facsimile No.

Teleprinter No.

2. The International Bureau hereby notifies the applicant that the following change has been recorded concerning:

☐ the person ☐ the name ☒ the address ☐ the nationality ☐ the residence

Name and Address

JEGANATHAN, Suruliappa, Gowper
2402 Windfield Court
Glen Mills, PA 19342
United States of America

State of Nationality

IN

State of Residence

US

Telephone No.

Facsimile No.

Teleprinter No.

3. Further observations, if necessary:

4. A copy of this notification has been sent to:

☒ the receiving Office ☐ the designated Offices concerned
☐ the International Searching Authority ☒ the elected Offices concerned
☐ the International Preliminary Examining Authority ☐ other:

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Facsimile No.: (41-22) 740.14.35

Authorized officer

Catherine Massetti

Telephone No.: (41-22) 338.83.38

PCT

NOTIFICATION OF ELECTION

(PCT Rule 61.2)

From the INTERNATIONAL BUREAU

To:

Assistant Commissioner for Patents
United States Patent and Trademark
Office
Box PCT
Washington, D.C. 20231
ETATS-UNIS D'AMERIQUE

in its capacity as elected Office

Date of mailing:

27 April 2000 (27.04.00)

International application No.:

PCT/EP99/07616

Applicant's or agent's file reference:

A-21851/A

International filing date:

11 October 1999 (11.10.99)

Priority date:

19 October 1998 (19.10.98)

Applicant:

JEGANATHAN, Suruliappa, Gowper et al

1. The designated Office is hereby notified of its election made:

☒

in the demand filed with the International preliminary Examining Authority on:

17 February 2000 (17.02.00)

☐

in a notice effecting later election filed with the International Bureau on:

2. The election ☒ was

☐

was not

made before the expiration of 19 months from the priority date or, where Rule 32 applies, within the time limit under Rule 32.2(b).

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Facsimile No.: (41-22) 740.14.35

Authorized officer:

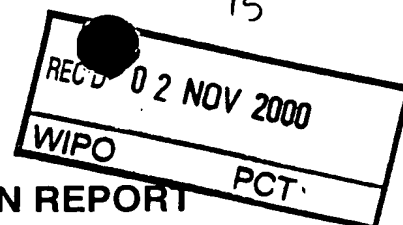
J. Zahra

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PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)



Applicant's or agent's file reference A-21851/A		FOR FURTHER ACTION	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)
International application No. PCT/EP99/07616	International filing date (day/month/year) 11/10/1999	Priority date (day/month/year) 19/10/1998	
International Patent Classification (IPC) or national classification and IPC G03C7/392			
Applicant CIBA SPECIALTY CHEMICALS HOLDING INC. et al.			

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.


2. This REPORT consists of a total of 6 sheets, including this cover sheet.

- ☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☒ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☒ Certain observations on the international application

Date of submission of the demand 17/02/2000	Date of completion of this report 31.10.2000
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized officer Hillebrecht, D Telephone No. +49 89 2399 8168



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/EP99/07616

I. Basis of the report

1. This report has been drawn on the basis of (*substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.*):

Description, pages:

1-47 as originally filed

Claims, No.:

1-16 as originally filed

2. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

4. Additional observations, if necessary:

IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees the applicant has:

- ☐ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☐ neither restricted nor paid additional fees.

2. ☒ This Authority found that the requirement of unity of invention is not complied and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/EP99/07616

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- ☐ complied with.
- ☒ not complied with for the following reasons:

see separate sheet

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☒ all parts.
- ☐ the parts relating to claims Nos. .

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims	1-11,14-16
	No:	Claims	12,13
Inventive step (IS)	Yes:	Claims	
	No:	Claims	1-16
Industrial applicability (IA)	Yes:	Claims	1-16
	No:	Claims	

2. Citations and explanations

see separate sheet

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

Reference is made to the following documents:

- D1: GB-A-2 294 043 (CIBA-GEIGY) 17 April 1996
- D2: EP-A-0 871 066 (AGFA-GEVAERT) 14 October 1998 cited in the application
- D3: EP-A-0 648 765 (CIBA-GEIGY) 19 April 1995 & US 5 607 624 A cited in the application
- D4: GB-A-2 322 861 (CIBA) 9 September 1998
- D5: GB-A-2 267 088 (CIBA-GEIGY) 24 November 1993
- D6: WO 80 01566 A (SANDOZ) 7 August 1980 & US 4 611 016 A cited in the application

- IV. The subject-matter of independent claims 1, and 11 to 16 is already known/not inventive (see the grounds for these objections). The requisite unity of invention (Rule 13.1 PCT) therefore no longer exists inasmuch as a technical relationship involving one or more of the same or corresponding special technical features in the sense of Rule 13.2 PCT does not exist between the subject-matter of the following groups of dependent claims:

Any new compound or group of compounds, showing a common linking feature not known from the prior art, used in any of the independent claims must be regarded as a separate invention.

The alleged invention resides in the use of benzofuran-2-ones in photographic materials as Dox-scavengers. However, said benzofuran-2-ones are generally known as stabilizers e.g. for stabilizing polymer compositions against degradation. Thus any use except the use as Dox scavengers must be regarded as a separate invention, even the use of novel compounds as polymer stabilizers.

It is thus presently not clear how many separate "inventions" exist in the present application.

V.

1. Claims 12 and 13, claiming a photographic or digital recording material comprising a compound of formula IV, and the respective use as an additive, lack novelty in view of document D1, in contrast to Article 33(1) and (2) PCT. D1 is directed to stabilized photographic materials. In addition to the triazine stabilizer used in D1, the material may also comprise benzofuranones as detailed in the paragraph bridging pages 30 and 31. At least some of them are covered by formula (IV) of D1.

2. The subject-matter of claims 1 to 16 lack an inventive step regarding documents D2 to D6. (Article 33(1) and (3) PCT)

2.1 Benzofuran-2-ones are known to be effective stabilizers, stabilizing organic components against degradation by light, oxidation, and/or heat. A variety of compounds differing in different substitution patterns are known from the prior art documents, cf. also those documents of the International Search Report which are not cited herein. The ensemble of documents shows that all compounds cited therein are effective stabilizers provided that they are based on a benzofuran-2-one nucleus.

2.2 Present claim 12 defines a colour photographic material or digital recording material comprising a compound of formula IV. First, it is submitted that in this claim the purpose for preventing migration of oxidized developer is not longer of relevance. Benzofuranones can be used in photographic materials to stabilize polymeric layers (cf. D1, pages 30 to 31) and oxidized developers are definitely no problem in digital recording materials. Moreover, compounds of formula IV are already covered by the general formula of claim 2 of D6. Even when regarded as a selection in view of D6, applicants did not provide the evidence for an unexpected advantage obtained by this selection. Nevertheless, the skilled worker starting from D6 would expect that compounds of formula IV are effective stabilizers for polymeric materials as used in photographic and digital recording materials.

These observations apply also to the subject-matter of claim 13.

2.3 Turning now to claims 14 to 16 it is submitted that these claims lack in inventive step in view of D3 to D6. Both compounds of formulae V and VI are covered by the general teaching of D6. Especially, compounds 10, 11, 41, 46, and 62 are very similar to present formula V. Those compounds are not within the present claims, since "t" must not be 1 or 2. However, the relevance of this arbitrary selection has not been proved.

2.4 D3 (tables 1 and 2) shows compounds differing from those of formula V only in that the 5- and 7-positions carry a t-butyl group instead of a t-pentyl group. However, it is obvious for those skilled in the art that the function of the compound is not affected by replacing a bulky group by a homologous group. Neither did the applicants prove the contrary. Cf. also D4, claim 2, and page 20, bottom)

2.5 Moreover, compound 115 of D5 differs from the definition of formula VI only in that the phenyl ring carries an alkoxy group, which is presently not included. The skilled worker, knowing that the R₁-O- group in formula (I) of D5 is essential for the compounds of D5, would nevertheless expect a sufficient performance as stabilizer, cf. also D6 and other documents, which do not require such a group

providing efficient stabilizers.

- 2.6 Document D2 is especially relevant for claim 1 and teaches that benzofuran-2-ones of formula (I) can be used as Dox-scavengers. The exemplary compounds of D2 have been disclaimed in present claim 1 by a proviso. However, the general teaching of D2 is still within the scope of claim 1. Claim 1 and the dependent claims lack an inventive step in view of D2, since a disclaimer may establish novelty over an anticipating document but fails to establish an inventive step.

VIII. The present application does not comply with the requirements of Article 6 PCT (clarity) for the reasons set forth below:

1. The claims are not concise. E.g. claim 1 claims a process wherein an enormous number of compounds of formula (I) can be used. Due to the huge number of substituents and combinations thereof it appears to be very difficult and requires undue burden to verify whether a specific embodiment falls within the scope of the claim.
2. Index "q" in claims 12 and 14 is apparently not defined. Moreover, the substituents R_2 , R_3 , R_5 , and R_7 to R_{11} in claim 14 are not defined.

PCT PATENT COOPERATION TREATY

WO 00/23849/B
PCT/EP99/07616

From the INTERNATIONAL BUREAU

PCT

NOTICE INFORMING THE APPLICANT OF THE COMMUNICATION OF THE INTERNATIONAL APPLICATION TO THE DESIGNATED OFFICES

(PCT Rule 47.1(c), first sentence)

To: CIBA SPECIALTY CHEMICALS HOLDING INC. Patentabteilung Klybeckstrasse 14 CH-4057 Basel SUISSE		
Ressort P/TM/SI	LE 5	
5. Mai 2000		
PATA	PATH	SES RSU

Date of mailing (day/month/year) 27 April 2000 (27.04.00)		
Applicant's or agent's file reference A-21851/A		
IMPORTANT NOTICE		
International application No. PCT/EP99/07616	International filing date (day/month/year) 11 October 1999 (11.10.99)	Priority date (day/month/year) 19 October 1998 (19.10.98)
Applicant CIBA SPECIALTY CHEMICALS HOLDING INC. et al		

1. Notice is hereby given that the International Bureau has communicated, as provided in Article 20, the international application to the following designated Offices on the date indicated above as the date of mailing of this Notice:
- AU,CN,JP,KP,KR,MA,US

In accordance with Rule 47.1(c), third sentence, those Offices will accept the present Notice as conclusive evidence that the communication of the international application has duly taken place on the date of mailing indicated above and no copy of the international application is required to be furnished by the applicant to the designated Office(s).

2. The following designated Offices have waived the requirement for such a communication at this time:

AE,AL,AM,AP,AT,AZ,BA,BB,BG,BR,BY,CA,CH,CR,CU,CZ,DE,DK,DM,EA,EE,EP,ES,FI,GB,GD,GE,
GH,GM,HR,HU,ID,IL,IN,IS,KE,KG,KZ,LC,LK,LR,LS,LT,LU,LV,MD,MG,MK,MN,MW,MX,NO,NZ,OA,
PL,PT,RO,RU,SD,SE,SG,SI,SK,SL,TJ,TM,TR,TT,TZ,UA,UG,UZ,VN,YU,ZA,ZW

The communication will be made to those Offices only upon their request. Furthermore, those Offices do not require the applicant to furnish a copy of the international application (Rule 49.1(a-bis)).

3. Enclosed with this Notice is a copy of the international application as published by the International Bureau on 27 April 2000 (27.04.00) under No. WO 00/23849

REMINDER REGARDING CHAPTER II (Article 31(2)(a) and Rule 54.2)

If the applicant wishes to postpone entry into the national phase until 30 months (or later in some Offices) from the priority date, a demand for international preliminary examination must be filed with the competent International Preliminary Examining Authority before the expiration of 19 months from the priority date.

It is the applicant's sole responsibility to monitor the 19-month time limit.

Note that only an applicant who is a national or resident of a PCT Contracting State which is bound by Chapter II has the right to file a demand for international preliminary examination.

REMINDER REGARDING ENTRY INTO THE NATIONAL PHASE (Article 22 or 39(1))

If the applicant wishes to proceed with the international application in the national phase, he must, within 20 months or 30 months, or later in some Offices, perform the acts referred to therein before each designated or elected Office.

For further important information on the time limits and acts to be performed for entering the national phase, see the Annex to Form PCT/IB/301 (Notification of Receipt of Record Copy) and Volume II of the PCT Applicant's Guide.

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer J. Zahra
Facsimile No. (41-22) 740.14.35	Telephone No. (41-22) 338.83.38